

## **REMARKS**

The present remarks are in response to the rejection dated September 02, 2005, in which the Examiner rejected claims 1-16 and 21-23. Applicant has amended claims 1, 6-8, 10, 12, and 14-15 and cancelled claim 3 and 5. The Applicant respectfully responds to the Examiner's Detailed Action and requests the Examiner place all claims detailed in the application in a state of allowance.

### **A. Support for Claim Amendments**

The Examiner shall appreciate that support for the claim amendments is provided in the patent application. More specifically, the patent application is directed to providing, through the impact of a ball with a hitting instrument, a dimple pattern, a strike zone, and at least one ridge as shown in, *inter alia*, FIG. 5 of the patent application.

### **B. Rejection of Claims under 35 USC § 102**

Claims 1-4,8,12-13,15-16, and 21-23 have been rejected by the Examiner under 35 USC § 102 as being anticipated by US Patent 3,806,132, issued to Brandell et al (hereinafter referred to as "Brandell"). The Applicant respectfully disagrees and reserves the right to make arguments at a later time.

The Examiner bears the initial responsibility for supporting a rejection of a pendent application, including a rejection based on anticipation. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional

limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). MPEP 2131.

In general, the Applicant respectfully submits that the Examiner has confused an opaque and malleable material (disclosed in the patent application) with "a flat disk 2" (Brandell, Col. 3, Line 9). It is clearly represented in the prior art that the referenced "flat disk" is not directed to be malleable, nor is it configured to be deformed upon impact with a ball. Therefore, the Examiner's argument that the "flat disk" reads on the presented malleable material is moot. Similarly, the Examiner argues that an "adhesive sheet" (FIG 2, Brandell) reads on a deformable sheet. The "adhesive sheet", in functional actuality, reads on "the adhesive layer 18 on the back face of the deformable sheet 14" (patent application, Page 7, Lines 7-8). Thus, Applicant respectfully submits that the Examiner has misinterpreted the plain meaning of Applicant's claims, and Applicant reserves the right to presents the merits of these arguments at a later time.

As previously stated, the Applicant has limited the scope of the claims to overcome the Examiner's rejection. Brandell would naturally have some

deformation when hit due to its thickness. However, the deformation in Brandell does not disclose a structure which is capable of performing the recited limitations of the Applicant's amended claims. Generally, Applicant's amended claims include limitations directed to forming at least one impression wherein the impression comprises a strike zone and at least one ridge, and an opaque and malleable material affixed to a hitting instrument. Brandell teaches a small spherical object with a tab for easy removal that is adhesively attached to a golf ball and, when struck, is adhesively transferred to a hitting device.

Regarding amended independent claim 1, Brandell fails to teach or suggest, *inter alia*, a training aid configured to strike a ball that results in an impression in the training aid depicting where and how the ball was struck relative to a hitting instrument. More specifically, Brandell fails to teach the training aid comprising an opaque and malleable material that is connected to a deformable sheet. Additionally, Brandell fails to teach that, when the malleable material is struck (referenced example being a golf ball), an impression is formed, comprising a strike zone and at least one ridge that are used, *inter alia*, to determine how the ball was struck.

Claims 2, 4 and 21 are dependent claims of independent claim 1, which has been amended to include, *inter alia*, a training aid configured to attain an impression of a ball upon impact with a hitting instrument. Since Brandell fails to teach the limitations of independent claim 1, Applicant respectfully submits that claims 2, 4 and 21 overcome the obviousness rejection.

Amended independent claim 8 overcomes Brandell because Brandell fails to teach or suggest, *inter alia*, a training aid configured to strike a ball that results

in an impression in the training aid depicting where and how the ball was struck relative to a hitting instrument. More specifically, Brandell fails to teach the training aid comprising an opaque and malleable material that is connected to a deformable sheet. Additionally, Brandell fails to teach that, when the malleable material is struck (referenced example being a golf ball), an impression is formed, comprising a strike zone and at least one ridge that are used, *inter alia*, to determine how the ball was struck. Furthermore, Brandell fails to teach a means for determining how the ball was struck according to information derived from the impression. Further still, the referenced FIG 6 of Brandell is directed to packaging of multiple devices while claim 8 is directed to a single device comprising, *inter alia*, a first and a second sheet, thus making the argument that Brandell discloses a first and second sheet (FIG 6) moot.

Referring to amended independent claim 12, Brandell fails to teach or suggest, *inter alia*, a training aid configured to strike a ball that results in an impression in the training aid depicting where and how the ball was struck relative to a hitting instrument. More specifically, Brandell fails to teach the training aid comprising a sheet having a metallic top layer configured to be deformed through operable contact with the ball. Additionally, Brandell fails to teach that, when the malleable top layer is struck (referenced example being a golf ball), an impression is formed, comprising a dimple pattern, a strike zone and at least one ridge that are used, *inter alia*, to determine how the ball was struck. Furthermore, Brandell fails to teach or suggest the sheet having, on its back face, an adhesive layer configured to attach to the hitting instrument before striking the ball. Further still, the referenced FIG 6 of Brandell is directed to packaging of

multiple devices while claim 8 is directed to a single device comprising, *inter alia*, a first and a second sheet, thus making the argument that Brandell discloses a first and second sheet (FIG 6) moot.

Claims 13, 15-16, and 23 are dependent claims of independent claim 12, which has been amended to include, *inter alia*, a training aid configured to attain an impression of a ball upon impact with a hitting instrument. Since Brandell fails to teach the limitations of independent claim 12 that claims 13, 15-16, and 23, Applicant respectfully submits that claims 13, 15-16, and 23 overcome the obviousness rejection.

Claim 22 is a dependent claim of independent claim 8, which has been amended to include, *inter alia*, a training aid configured to attain an impression of a ball upon impact with a hitting instrument. Since Brandell fails to teach the limitations of independent claim 8 that claim 22 depends on, Applicant respectfully submits that claim 22 overcome the obviousness rejection.

**C. Rejection of Claims Under USC § 103**

Claims 2-16, 22, and 23 have been rejected by the examiner under 35 USC § 103 as being unpatentable over US Patent 5,033,746, issued to Jones et al (hereinafter referred to as "Jones") in view of Brandell. The Applicant respectfully disagrees and reserves the right to make arguments at a later time; however, to expedite the prosecution of this patent application, the Applicant has amended claims 8, 10, 12, and 14-15 as described below.

Claims 2, 4, 6 and 7 depend from independent claim 1, which has been amended to include, *inter alia*, a training aid configured to attain an impression of

a ball upon impact with a hitting instrument, the impression comprising a strike zone and at least one ridge. Additionally, the information regarding how hard the ball was struck, the location of the ball strike on the hitting instrument, and whether the ball was struck on the downstroke or upstroke are described *inter alia* in FIG. 5-6 of the patent application. Since Jones in view of Brandell fails to teach the limitations of independent claim 1, Applicant respectfully submits that the dependent claims 2, 4, 6 and 7 overcome the obviousness rejection.

With respect to claim 8, the Examiner has failed to satisfy prima facie obviousness requirements by failing to show how Jones is associated with the obviousness rejection. Thus, Applicant repeats the argument that amended claim 8 teaches away from Brandell because Brandell fails to teach or suggest, *inter alia*, a training aid configured to strike a ball that results in an impression in the training aid depicting where and how the ball was struck relative to a hitting instrument. More specifically, Brandell fails to teach the training aid comprising an opaque and malleable material that is connected to a deformable sheet. Additionally, Brandell fails to teach that, when the malleable material is struck (referenced example being a golf ball), an impression is formed, comprising a strike zone and at least one ridge that are used, *inter alia*, to determine how the ball was struck. Furthermore, Brandell fails to teach a means for determining how the ball was struck according to information derived from the impression. Further still, the referenced FIG 6 of Brandell is directed to packaging of multiple devices while claim 8 is directed to a single device comprising, *inter alia*, a first and a second sheet, thus making the argument that Brandell discloses a first and second sheet (FIG 6) moot.

Claims 9-11 and 22 depend from independent claim 8, which has been amended to include, *inter alia*, a training aid configured to attain an impression of a ball upon impact with a hitting instrument. Additionally, referring to claim 9, the Examiner can find information about the unexpected results such as, but not limited to, how hard, which location on the hitting instrument, and whether it was struck on the downstroke or upstroke, *inter alia*, in FIG. 5-6 of the patent application. Furthermore, with respect to claim 10, the impressions of Jones and Brandell do not suggest or teach a means for determining how the ball was struck, comprising how hard, which location on the hitting instrument, and whether it was struck on the downstroke or upstroke. Since Jones in view of Brandell fails to teach the limitations of independent claim 8, and dependent claims 9-11 and 22, Applicant respectfully submits that claims 9-11 and 22 overcome the obviousness rejection.

With respect to claim 12, the Applicant respectfully submits that the Examiner has again failed to meet the prima facie obviousness requirements because the Examiner has failed to describe how Jones teaches each element of the claims. Amended independent claim 12 teaches, *inter alia*, a training aid configured to strike a ball that results in an impression in the training aid depicting where and how the ball was struck relative to a hitting instrument. Brandell fails to teach the training aid comprising a sheet having a metallic top layer configured to be deformed through operable contact with the ball. Additionally, Brandell fails to teach that, when the malleable top layer is struck (referenced example being a golf ball), an impression is formed, comprising a dimple pattern, a strike zone and at least one ridge that are used, *inter alia*, to

determine how the ball was struck. Furthermore, Brandell fails to teach or suggest the sheet having, on its back face, an adhesive layer configured to attach to the hitting instrument before striking the ball. Further still, the referenced FIG 6 of Brandell is directed to packaging of multiple devices while claim 8 is directed to a single device comprising, *inter alia*, a first and a second sheet, thus making the argument that Brandell discloses a first and second sheet (FIG 6) moot.

Claims 13-16 and 23 depend from independent claim 12, which has been amended to include, *inter alia*, a training aid configured to attain an impression of a ball upon impact with a hitting instrument. Since Brandell fails to teach the limitations of independent claim 12 that claims 13-16 and 23, Applicant respectfully submits that claims 13-16 and 23 overcome the obviousness rejection.




**D. Conclusion**

For all the forgoing reasons, allowance of claims 1-2, 4, 6-16, and 21-23 is respectfully requested.

Respectfully Submitted;

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